

**REMARKS/ARGUMENTS**

**I. STATUS OF THE CLAIMS**

With entry of this amendment, claims 1-54 are currently pending. Claims 1, 11, 12, 28, 29, 34- 37 are currently amended, claims 10 and 33 are canceled, and claims 42-54 are newly added. Support for the amendments can be found throughout the specification, drawings, and claims as originally filed.

Claim 1 is amended to incorporate the limitations previously recited in claim 10. Support for the amendment can be found in claim 10, which is hereby canceled with entry of this amendment. Claims 11 and 12 are amended to correct their dependency from claim 10 (now canceled) to claim 1. Claim 28 is amended to incorporate the limitation previously recited in claim 33. Support for the amendment can be found in claim 33, which is hereby canceled with entry of this amendment. Claims 34 and 35 are amended to correct their dependency from claim 33 (now canceled) to claim 28. Claim 28 is further amended to clarify that "a reaction vessel having a reaction chamber and at least one port for adding fluid to the chamber, and wherein the chamber has at least one flexible wall" is a positively recited element of the apparatus. Support for the amendment can be found in the preamble of claim 28 as previously presented. Claim 29 is amended to recite that the vessel further comprises a first and a second major flexible wall. Support for the amendment can be found, for example, at page 6, lines 16-21 and at page 15, line 22 to page 16, line 4 of the specification. Claim 36 is amended to clarify that the "means for dispensing" refers to the automated machine element of claim 28. Claim 37 is amended for reasons similar to that of claim 28, to clarify that the limitations previously recited in the preamble are intended to be positively recited elements of the claim. Support for the amendment can be found in the preamble of claim 37 as previously presented.

Claims 42-54 are newly added. Support for the new claims can be found throughout the specification, claims, and drawings as originally filed. For example, support for claim 42 can be found in claim 3 as originally filed. Support for claim 43 can be found in claim 5 as originally filed and at page 6, lines 21-23 of the specification. Support for claims 44-46 can be found in claims 9, 11, and 12 as originally filed. Support for claim 47 can be found in claims

1 and 19 as originally filed. Support for claim 48-54 can be found in claims 20-27 as originally filed. No new matter is added.

## **II. REJECTIONS UNDER 35 U.S.C. §112, SECOND PARAGRAPH**

Claims 36-38 stand rejected under 35 U.S.C. §112, second paragraph as being indefinite for failing to point out and distinctly claim the subject matter that the Applicant regards as the invention. In particular, the Examiner alleges that claims 36 and 37 recite multiple means for clauses, including "means for dispensing fluid", "means for inserting", and "means for injection." The Examiner alleges that it is unclear what specific elements the applicant considers to define such means.

With regard to claim 38, which depends from claim 37, the Examiner notes that "the needle" was not a positively claimed element of the apparatus, and a means for inserting a needle does not necessarily include the needle.

Applicants thank the Examiner for the careful reading of the claims and note that claim 36 is amended to clarify that the "means for dispensing fluid" refers to the automated machine element. Structural support for a means for dispensing can be found throughout the specification, for example, in figures 33-34 and at page 75, line 7 through page 77 line 20 of the specification.

Similarly, claim 37 as presently amended makes clear that the vessel is further limited to include a channel connecting the port to the chamber, and an elastomeric plug, and that the automated machine is further limited to comprise a needle and means for inserting the needle as well as means for injecting fluid through the needle. Thus, claim 37 as presently recited makes clear that it is the automated machine that defines the means for clauses recited in claim 37. The specification provides structural support for the means for inserting the needle and means for injecting fluid through the needle in figures 34-36 of the specification, and at page 77 line 22 through page 79 line 19 of the specification.

With regard to claim 38, it is to be noted that this claim depends from claim 37, which is presently amended to recite "a needle...." Thus, claim 38 is not vague or indefinite in view of the amendment to claim 37.

In light of claims 36 and 37 as presently amended, and the arguments presented above, Applicants request that the Examiner withdraw the rejections to claims 36-38.

### **III. REJECTION UNDER 35 U.S.C. §102(e)**

Claims 28, 32-34, and 36 stand rejected under 35 U.S.C. §102(e) as allegedly being anticipated by Tajima *et al.* (U.S. Pat. No. 6,509,193). In particular, the Examiner alleges that Tajima *et al.* discloses a pipetting machine comprising essentially all of the elements of claims 28, 32-34 and 36 as previously presented. Applicants disagree.

Tajima *et al.* discloses a pipetting machine that includes *inter alia*, a mechanical distribution unit (machine head and means for inserting), and numerous automatic control units including, an input/output control unit, a pipette device control unit (automated machine and means for dispensing and injecting), and a constant temperature control unit for maintaining a constant temperature in a thermostatic oven or heater. *See*, page 4, Item 4, of the Office Action.

Tajima, *et al.*, however, does not disclose a reaction vessel having, *inter alia*, at least one flexible wall as presently recited in independent claim 28. Because Tajima *et al.* does not disclose all of the elements of independent claim 28 as presently recited, Tajima *et al.* does not anticipate independent claim 28.

Claims 32-34 and 36 depend either directly or indirectly from independent claim 28 and include all of the limitations of independent claim 28. Therefore, the arguments as presented above, are applicable to dependent claims 32-34 and 36.

In light of the claims as amended and the arguments as presented above, Applicants request that the Examiner withdraw the rejection.

### **IV. NON-STATUTORY DOUBLE PATENTING REJECTION**

Claims 1-8, 10, 11, 13-16, 18, 28-35 and 39 stand rejected on the grounds of nonstatutory obviousness type double-patenting as allegedly being unpatentable and obvious over claims 1-5, 14, 15, 19-21, 23, 24, and 44 of U.S. Pat. No. 6,403,037. Applicants submit herewith, a terminal disclaimer over U.S. Patent No. 6,403,037.

In view of the executed terminal disclaimer to U.S. Patent No. 6,403,037, submitted herewith, Applicants request that the Examiner withdraw the rejection.

Appl. No. 10/719,073  
Amdt. dated July 24, 2008  
Reply to Office Action of January 24, 2008

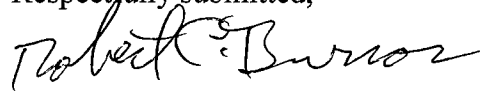
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**CONCLUSION**

In view of the foregoing, Applicants believe all claims now pending in this Application are in condition for allowance. The issuance of a formal Notice of Allowance at an early date is respectfully requested.

If the Examiner believes a telephone conference would expedite prosecution of this application, please telephone the undersigned at 415-576-0200.

Respectfully submitted,



Robert C. Burrows, Ph.D.  
Reg. No. 61,039

TOWNSEND and TOWNSEND and CREW LLP  
Two Embarcadero Center, Eighth Floor  
San Francisco, California 94111-3834  
Tel: 415-576-0200  
Fax: 415-576-0300  
Attachments  
RCB:rcb  
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